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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,021	02/17/2004	Fermin Marquez Arzate	MX/JFC04-01	9594

7590 08/08/2005

Law Office of Carmen Pili Ekstrom
727 Sunshine Dr
Los Altos, CA 94024

EXAMINER

MAYO III, WILLIAM H

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H-A

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/780,021

Applicant(s)

ARZATE ET AL.

Examiner

William H. Mayo III

Art Unit

2831

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

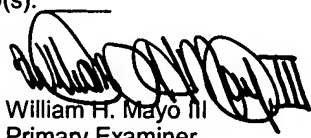
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: the arguments presented are not persuasive (see enclosed rebuttals).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____.


William H. Mayo III
Primary Examiner
Art Unit: 2831

DETAILED ACTION

Drawings

1. The drawings were received on July 20, 2005. These drawings are not approved.

Response to Arguments

2. Applicant's arguments filed July 20, 2005 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:
 - A) Claims 33, 37, and 42 are definite and therefore the rejection under 35 USC 112, second paragraph is improper.
 - B) The rejection of the claims under 35 USC 103(a) should be withdrawn because there is no motivation or suggestion to combine the prior art and arrive at the claimed invention.
 - C) The examiner has improperly used Applicant's own teaching to construct the obviousness rejection and therefore has engaged in impermissible hindsight.
 - D) The examiner has improperly ignored the applicant's claim limitation because the applicant's recite the swelling layer being deposited electrostatically onto cable components and this limitation is not taught in the prior art reference.

- E) The examiner cannot apply a 35 USC 102 anticipation rejection in a 35 USC 103 obviousness rejection.

With respect to argument A, the examiner respectfully traverses. Clearly, in claim 33, the applicant recites "the transmission circuit" in line 7, which is confusing and renders the claim indefinite. It is unclear whether the applicant is referring to the previously mentioned "one or plurality of transmission circuits" or introducing a new main transmission circuit. Specifically, by reciting "the transmission circuit, the applicant is limiting the number of circuits to a single circuit, when essentially the previous recited term "one or more transmission circuits" suggest that the number of transmission circuits may be one, two, three, or more. This claim language "the transmission circuit", renders the claim indefinite because it is not clear if the applicant intends to refer to one of the plurality of transmission circuits as opposed to all of the two, three, or more circuits. Therefore, if the applicant is referring to the previously mentioned term, then he/she should recite the term with consistency to provide clear metes and bounds of the claim. In light of the above, the examiner respectfully submits that the 35 USC 112, second paragraph rejection is proper.

With respect to argument B, the examiner respectfully traverses. Firstly, the examiner would respectfully state, that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Osornio discloses a telephone lead in cable (Figs 1-3) for voice, data, and video (VVDL) transmission services (abstract), except the cable comprising a swelling layer surrounding said core electrostatically deposited as moisture protection element made of conventional poly (sodium acrylate) homopolymer compound and it is applied through electrostatic means forming a cover layer on the stranded pair during the extrusion of the flame resistant reinforced thermoplastic cover. Clearly, Osornio also teaches that he is concerned with protecting the interior components from exterior elements, such as water, because Osornio states that such exterior elements, such as water cause of the mature aging of the interior components of the cable (Page 2, paragraph 15). Asai teaches a water swellable material, which is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). Based on the teachings of both Osornio and Asai, there clearly exist a motivation to incorporate the waterproofing filler as taught by Asai into the cable of Osornio because Osornio discloses that he is concerned with premature aging of the cable resulting from the intrusion of water and Asai teaches a filler component that is cost efficient, has good wetting on and adhesion to many surfaces, and may be applied to cable components, such as wires, rods, tubes, and strength members, to provide the cable with water blocking properties (Col 1 & 3, lines 1-13 & 11-29). Secondly, there exist a reasonable amount of success, since Asai specifies that the filler material may be utilized on interior components such as wires and strength members,

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both of which exist in the cable of Osornio, of which he is trying to waterproof (see Page 2, paragraph 15). Thirdly, all of the claimed elements are disclosed with the combination of Osornio and Asai. Therefore, a proper prima facie case of obviousness has been established, as all of the components to establish a prima facie case of obviousness, as disclosed by the MPEP are denoted. While In light of the above comments, the examiner respectfully submits that there does exist a proper motivation for combining the teachings of Osornio and Asai, and that the 35 USC 103(a) rejection is proper.

With respect to argument C, the examiner respectfully traverses. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to argument D, the examiner respectfully traverses. Firstly, the examiner would like to state that the courts have been consistent on process limitations in product claims. Specifically, it has been held that the presence of process limitations in product claims, in which the product doesn't otherwise patentably distinguish over the prior art, cannot impart patentability to that product. 145 USPQ 656 (CCPA 1965) Secondly, clearly Asai teaches a water swellable material composition, which may be poly(sodium acrylate) homopolymer compound (Col 5, lines 9-15 & 26-40) and may be

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applied through electrostatic (i.e. laser) means on a cover layer on the stranded pair during the extrusion of the cover layer (Cols 8-9, 61-67 & 1-8, respectively). Therefore, the claim limitation of being "applied through electrostatic means" is clearly disclosed in Asai. In light of the above, the examiner respectfully submits that the rejections stated above are proper and just.

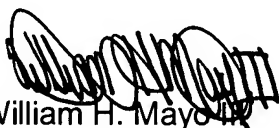
With respect to argument E, the examiner respectfully traverses. Firstly, the examiner would like to state that not 35 USC 102 rejection has been made and therefore this argument seems moot. However, if the applicant is intending on referring to the case law that was cited in support of the rebuttal presented in the final rejection, it is respectfully submitted that this case law was cited to support the fact, that if a specific species of element(s) is recited in an abundance of elements, it still anticipates or renders a claim obvious. Specifically, the courts have been consistent that the courts have been consistent that if a species (configuration) is clearly named, the species claimed is anticipated or rendered obviousness no matter how many other species are additional named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App & Inter. 1990). Further, it is axiomatic that it is not necessary for a finding of obviousness under 35 USC 103(a) that all of the elements or teachings of one reference be fully combined with those of another reference. In re Griver, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966): In re Billingsley, F.2d 689, USPQ 370, (CCPA 1960).

Communication

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William H. Mayo III
Primary Examiner
Art Unit 2831

WHM III
August 4, 2005

NOT
Approved
8/4/05



3/3

FIG. 3

